

Claim 24 stands rejected as being anticipated by *Simone*. Applicants have amended Claim 24 to claim a moisture content of less than 10% by weight. *Simone* teaches a moisture content of at least 12% by weight, and preferably 16 to 35% by weight (see column 5, lines 5-10). Accordingly, the anticipation rejection has been overcome by the amendment to the claim and Applicants respectfully request that it be withdrawn.

Claims 1-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Simone* in view of *Hand*. Applicants respectfully submit that this rejection is not proper and should be withdrawn.

In Applicants' previous Amendment, Applicants pointed out how *Simone* does not teach the claimed invention. In this regard, each of the claims of Applicants' patent application now includes the limitation that the moisture content of the product is less than 10% by weight. In contrast to the claimed invention, *Simone* discloses, that the moisture content must be at least 12% by weight and preferably is greater. To remedy this deficiency, the Patent Office now points to *Hand* as allegedly disclosing a moisture level of 5-11%. Applicants respectfully submit that there is no motivation to modify *Simone* based on *Hand* and indeed, if anything, the references teach away from so modifying *Simone*.

The test is not whether or not the prior art can be modified so as to realize Applicants' claimed invention. Indeed, "the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability and modification." *In re Laskowski*, 871 F.2d 115 (Fed.Cir. 1989). In this regard, "there must be some reason, suggestion, or motivation found that the prior art whereby a person of ordinary skill in the field of the invention would make the combination. The knowledge can not come from the Applicants' invention itself." *In re Oetiker*, 977 F.2d 1443 (Fed.Cir. 1992).

In determining obviousness in view of a reference, a reference must be considered as a whole. Those portions arguing against or teaching away from the claimed invention must be considered. *Bausch & Lomb Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed.Cir. 1986). Indeed, nonobviousness can be demonstrated by the fact that the closest prior art reference "would likely discourage the art worker from attempting the substitution suggested by the [inventor]." *Gillette Co. v. S.C. Johnson & Son Inc.*, 919 F.2d 720 (Fed.Cir. 1990).

Using the proper obviousness analysis, Applicants respectfully submit that the rejection is not proper.

In the first instance, there is no motivation to modify *Simone* in view of *Hand*. *Simone* teaches, and the whole invention is directed to, providing improved flexibility in a chew product by increasing the moisture content of the chew (for example, see column 5, line 5-10). Accordingly, why would one be motivated to reduce the moisture content in *Simone*? Where is the motivation in *Hand* to suggest to one to disregard the gist of the invention of *Simone* and reduce the moisture content?

Simone and *Hand* are directed to different concepts: one provides a hard brittle chew product; and the other provides a flexible chew product. The *Simone* product is designed not to fracture (see, for example, column 5, lines 35-38), the *Hand* product is designed to fracture (see, for example, column 4, lines 32-42). There is, Applicants respectfully submit, no motivation to combine the references.

Furthermore, *Simone* is the principle reference relied upon by the Patent Office. *Simone* teaches away from the claimed invention; *Simone* requires a moisture content of at least 12% or greater. Accordingly, the principle reference in the rejection discourages one skilled in the art

from the claimed invention. This in and of itself demonstrates nonobviousness. *Gillette Co. v. S.C. Johnson and Son Inc.*, 919 F.2d 720 (Fed.Cir. 1990).

Moreover, the owner of *Simone* and *Hand* does not believe the references are relevant to each other. In this regard, although *Simone* and *Hand* are owned by the same assignee, *Simone* and *Hand* have different filing dates and different inventive entities. Accordingly, *Simone* which has the earlier filing date is prior art to *Hand*. *Simone* was not brought to the Patent Office's attention during the prosecution of *Hand*. The assignee of *Hand* had duty of candor to disclose to the Patent Office *Simone* if it was relevant to the *Hand* invention. The assignee did not do so. Obviously the assignee of *Simone* and *Hand* does not believe that these patents are relevant to each other. This is further proof that it would not have been obvious to one skilled in the art to modify *Simone* in view of *Hand*. Therefore, Applicants respectfully request that the rejection be withdrawn. } No

For the foregoing reasons, Applicants respectfully request reconsideration of their patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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